

REMARKS

Claims 1-24, 27-30, 32-42, 44-46, 48-50, and 52-56 are pending in the Office Action. By this Amendment, Claims 25-26, 31, 43, 47, 51 are canceled, Claims 1, 16-20, 22, 27, 30, 41-42, 44-46, 48-50 and 52 are amended, and new Claims 53-56 are added.

Applicants gratefully acknowledge the indication in the Office Action that Claims 3, 8, 13 and 27 contain allowable subject matter. Claim 27 has been amended and is now in independent form.

Objection - Declaration

In the Office Action, the Examiner asserts that the Declaration filed on 17 April 2000 is defective, and demands a new Declaration. Although Applicants continue to disagree with this requirement for reasons set forth in the Amendment filed 12 August 2002, a Supplemental Declaration is filed herewith under 37 C.F.R. § 1.67(a)(2).

The Supplemental Declaration is signed by the second named inventor, Donald J. Lindsay. The only alleged defect in the originally filed Declaration is the handwritten correction to Mr. Lindsay's country of citizenship. The alleged defect pertains only to Mr. Lindsay and neither relates to the first named inventor Arnaud Gourdol nor affects or alters any of the other information in the originally filed Declaration. Accordingly, if the alleged defect is in fact a true defect, then in accordance with 37 C.F.R. § 1.67(a)(2) the Supplemental Declaration filed herewith is a full and complete correction. Applicants respectfully submit that the Supplemental Declaration filed herewith obviates all concerns raised by the Examiner. Withdrawal of the Examiner's request for a new Declaration is respectfully requested.

Claim Rejection - 35 U.S.C. § 102(e) over Nowlan

In the Office Action, the Examiner rejects Claims 30-32 under 35 U.S.C. § 102(e) over U.S. Patent No. 6,169,538 to Nowlan (Nowlan). This rejection is respectfully traversed.

Nowlan discloses a system wherein as a user drags a pointer across a graphical user interface keyboard, the character or key beneath the pointer is enlarged, along with characters immediately adjacent the character underneath the pointer. See for example Figures 6-7 and column 4, line 60 to column 5, line 28. If the pointer is lifted, the key beneath the pointer is accepted as a text character. See for example column 4, lines 3-5. In this way a user can compose text, as shown for example in Figure 3. The zooming feature shown in Figures 6-7 helps the user identify the character beneath the pointer, which can be useful when the un-zoomed size of the character is small and hard to see (refer to column 1, lines 12-22).

The enlargement of the character or key beneath the pointer is based on whether the user has placed the pointer over the character or key, and is not based on any characteristic of an object which the character or key represents. Accordingly, Nowlan fails to disclose or suggest *displaying said icons with different relative sizes within said window, wherein the different sizes of said icons are based upon characteristics of objects represented by the icons*, as recited in Claim 30. For at least this reason, withdrawal of the rejection of Claims 30-32 under 35 U.S.C. § 102(e) over Nowlan is respectfully requested.

Claim Rejections - 35 U.S.C. § 103(a) over Nowlan, Grossman, Ulrich, *Windows*

In the Office Action, the Examiner rejects Claims 1-2, 4-7, 9-12, 14-26, 28-29, and 33-40 under 35 U.S.C. § 103(a) over a combination of Nowlan and Grossman. The Examiner also rejects Claims 41, 45, and 49 under 35 U.S.C. § 103(a) over Nowlan and Grossman in view of U.S. Patent No. 6,239,395 to Ulrich, *et al.* (Ulrich). The Examiner also rejects Claims 42-44, 49-48, and 50-52 under 35 U.S.C. § 103(a) over Nowlan and Grossman in view of *Windows 95 Uncut*, authored by Alan Simpson. These rejections are respectfully traversed.

Examiner's Statements

On page 4 of the Office Action, the Examiner states that "Nowlan alludes to varying the size of icons for signaling to the user icons that are more frequently selected." Applicants traverse this statement, and request the Examiner to cite a specific passage in Nowlan that teaches it.

On page 7 of the Office Action, the Examiner states that "Nowlan alludes to the need for varying the size of icons by allowing for the designating a greater amount of output screen real estate for more frequently selected icons." Applicants traverse this statement, and request the Examiner to cite a specific passage in Nowlan that teaches it.

On page 9 of the Office Action, the Examiner acknowledges that Nowlan and Grossman fail to disclose outputting data regarding the size, amount of memory used, number of files used, or any type of measure of how recently an object was added, but goes on to assert that "However, Nowlan and Grossman do suggest the need for such

information." Applicants traverse this assertion, and request the Examiner to cite specific passages in Nowlan Grossman that teach it.

Claim 1

Nowlan discloses a user selecting characters or keys by placing a pointer over the character or key. In response to the selection, the character or key is automatically enlarged. However, the user has no control over how much the character or key is enlarged. In contrast, Claim 1 recites *selecting individual icons to perform variable icon sizing and designating a user preference value for each of the selected icons, and generating icon images of different respective sizes, wherein the different sizes of the icon images are based upon said user preference values*. Nowlan fails to disclose or suggest these features, because Nowlan fails to disclose or suggest the user having control over how much the character or key is enlarged.

In the Advisory Action mailed 21 April 2003, the Examiner asserts that "the zoom taught by Nowlan (fig. 6, #42) demonstrates icon images that are based upon a user preference value." This assertion is respectfully traversed. Claim 1 of the present application recites *selecting individual icons to perform variable icon sizing*, and separately recites *designating a user preference value for each of the selected icons*. Nowlan discloses the user selecting icons with a pointer, which are then *automatically* enlarged to a predetermined size. Accordingly, Nowlan fails to disclose or suggest *designating a user preference value for each of the selected icons*, as recited in Claim 1.

In addition, Applicant notes that Claim 1 indicates that *icon images of different respective sizes* are generated for the selected individual icons based on the designated user

preference values. Since all of the Nowlan's selected characters or keys are enlarged the *same* amount, Nowlan fails to disclose or suggest that icon images of **different** respective sizes are generated for the **selected** individual icons, as recited in Claim 1. Nowlan further fails to disclose or suggest similar features recited in Claims 6 and 11. Grossman also fails to overcome these deficiencies of Nowlan.

Claims 53-55

For similar reasons, Grossman and Nowlan fail to disclose or suggest that *the designated user preference values are different for each of the selected icons*, as recited in new Claims 53-55.

Claims 16, 19 & 22

With respect to Claims 16, 19 and 22, both Nowlan and Grossman fail to disclose or suggest varying the size of a plurality of icons based upon an object characteristic, wherein the object characteristic is a number of files in the object, as recited in Claim 16, and similar features recited in Claim 19 and 22. Nowlan and Grossman likewise fail to disclose or suggest varying the size of a plurality of icons based on an object characteristic that is a size of the object, an amount of memory that the object uses, or a measure of how recently the object was added or amended, as variously recited in Claims 41-42, 44-46, 48-50, and 52. The Examiner asserts that Ulrich and *Windows* disclose objects having these characteristics. However, Ulrich and *Windows* disclose nothing more than that. In other words, Ulrich and *Windows* fail to disclose performing actions based on the characteristics, as encompassed by the presently pending claims.

Claims 42-46 & 50-52

The Examiner's assertion on pages 9-11 of the Office Action that variously combining Nowlan, Grossman, Ulrich and *Windows* to arrive at Applicants' claimed invention would have been obvious because "doing so allows users to access and view internal information related to the objects corresponding with said icons" is insufficient to establish a *prima facie* case of obviousness, because it is based on the Examiner's hindsight reconstruction. Nothing in the references cited by the Examiner teaches these claimed features. As set forth in *In re Mills*, 916 F.2d 608, 16 USPQ2d 1430 (Fed. Cir. 1990) the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. The Examiner has failed to show that the *prior art* suggests the desirability of the combination he is asserting, and thus has failed to present a *prima facie* case of obviousness with respect to these claims.

Claims 33, 37 & 39

With respect to Claims 33, 37 and 39, Applicants note that Nowlan and Grossman fail to disclose or suggest varying the size of a plurality of icon images displayed in a display device based upon a user designated size, by selecting individual icons to perform variable icon sizing and designating a *different respective icon size for each of the selected icons*, as recited in Claim 33, and similar features recited in Claims 37, 39. This is because Grossman fails to disclose a user selecting icons for variable sizing, and because Nowlan's selected icons are all increased to the same, larger size, not to *different* respective icon sizes.

Claims 2, 7, 12, 17, 20, 23 & 26

With respect to Claims 2, 7, 12, 17, 20, 23 and 26, the Examiner asserts on pages 5, 6 and 8 of the Office Action that Grossman teaches sorting icons into an order. This assertion is incorrect. Grossman discloses that when icons are not used, they are faded, eliminated or shrunk to a smaller size. See for example the abstract, and column 9, lines 43-55. In essence the icons are gradually *deleted* based on frequency of use. Thus Grossman discloses merely eliminating elements from a set, not "sorting into an order".

Summary

For at least the above reasons, Applicants respectfully submit that the asserted combinations of Nowlan, Grossman, Ulrich and *Windows* fail to disclose or suggest all of the features recited in the pending claims. Nowlan, Grossman, Ulrich and *Windows*, when considered both separately and in combination, likewise fail to disclose or suggest all features recited in new Claims 53-56. Withdrawal of the rejections of Claims 1-2, 4-7, 9-12, 14-26, 28-29, and 33-45, 48-49 and 50-52 under 35 U.S.C. § 103(a) over the various combinations of Nowlan, Grossman, Ulrich and *Windows* is respectfully requested.

Conclusion

Applicants respectfully submit that the application is in condition for allowance. Favorable consideration on the merits and prompt allowance are respectfully requested. In the event any questions arise regarding this communication or the application in general, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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